



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,617	04/12/2004	Mark A. Weiss	10379-6U2	3288
570 7590 10/01/2008 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103				
EXAMINER				
LETT, THOMAS J				
ART UNIT		PAPER NUMBER		
2625				
MAIL DATE		DELIVERY MODE		
10/01/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/822,617	Applicant(s) WEISS, MARK A.
Examiner THOMAS J. LETT	Art Unit 2625

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2 and 10-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Edward L. Coles/
Supervisory Patent Examiner, Art Unit 2625

/Thomas J. Lett/
Examiner, Art Unit 2625

Continuation of 7. will not be entered and an explanation of how the amended claims would be rejected is provided:

With respect to a phone conversation with Applicant's representative (24 September 2008) as a result of a request for an interview, Applicant requests entry of amendment after final but in reviewing the disclosure there is no support for the amended "article of manufacture". The addition of the phrase an "article of manufacture" in the preamble of the amended claims does not change the fact that the claimed invention is still a sheet of paper as defined by Applicant. The Applicant has defined the proofing paper as a sheet of paper in Applicant's parent application (serial # 10/192,404, now patent 6,721,068 B2). The parent patent (6,721,068 B2) defines the proofing material as paper at col. 2, lines 59-63 wherein digital information is added to a sheet of paper (in addition, see col. 3, lines 16-18). The "proofing" aspect in the parent occurs when a user inspects the two color bars 10 and 20 to try and detect any differences between the two color bars, see col. 1, lines 60-64, col. 4, lines 22-26 and abstract. The current application also defines the proofing material as a sheet of paper at paragraph 0023. The "proofing" aspect arises when a user of this sheet of paper compares color bars 10 and 20 of figure 2B for color differences, see paragraphs 0007 and 0038.

Continuation of 11. does NOT place the application in condition for allowance because: the claim language does not claim the invention. Regarding independent claims 1 and 12, Applicant still fails to define the boundaries of the regions (blank and marginal). For example, Applicant claims a marginal region "outside" of the blank region. This is not what is shown in the Applicant's drawings. In the Applicant's drawings (see figures 2A, 2B, 3A-3C), there is a blank sheet of paper (the blank sheet of paper is the blank region) and the marginal region with the color bar(s) is actually "inside" of the blank sheet of paper. Examiner had asked for this to be clarified in non-final Office action dated 28 September 2007 but Applicant does not make any effort to define any region boundaries. This complicates examination since Applicant argues the location of regions in Examiner's applied prior art.

The addition of the phrase an "article of manufacture" in the preamble of the amended claims does not change the fact that the claimed invention is still a sheet of paper as defined by Applicant. The Applicant has defined the proofing paper as a sheet of paper in Applicant's parent application (serial # 10/192,404, now patent 6,721,068 B2). The parent patent (6,721,068 B2) defines the proofing material as paper at col. 2, lines 59-63 wherein digital information is added to a sheet of paper (in addition, see col. 3, lines 16-18). The "proofing" aspect in the parent occurs when a user inspects the two color bars 10 and 20 to try and detect any differences between the two color bars, see col. 1, lines 60-64, col. 4, lines 22-26 and abstract. The current application also defines the proofing material as a sheet of paper at paragraph 0023. The "proofing" aspect arises when a user of this sheet of paper compares color bars 10 and 20 of figure 2B for color differences, see paragraphs 0007 and 0038.